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10/579,035	05/01/2007	Valerio Abate	J1036.0012/P012	4393
24998 7590 03/25/2008 DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403				
EXAMINER				
RAHMAN, MOHAMMAD N				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/579,035

Applicant(s)

ABATE ET AL.

Examiner

MOHAMMAD N. RAHMAN

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 5/10/2006
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Detailed Action

Claim objection

1. **Claim 13** is objected to because of the following informalities:

In claim 13 and line 9, it is written as "retrived". It should be "retrieved".

Therefore, proper correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. **Claims 15-19** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 15-18 lacks proper antecedent basis since, claim 15 recites in line 1, the method of claim 13. However, claim 13 is an apparatus claim.

In **claim 19**, line 7, "and/or box" lacks proper antecedent basis since, it does not make a clear conception.

Claim Rejection – 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1, 2 and 4-19** are rejected under 35 U.S.C. 102 (b) as being anticipated by Irons (U.S. Patent No. 6,192,165 B1) herein referred to as "Irons".

As per claim 1, Irons teaches, apparatus for managing documents (see at col. 6 and lines 18-33) comprising:

- "a device for acquiring at least one image of a document" at col. 7 and lines 10-37;

(Irons teaches, "Document input mechanism 110 is any type of device which is capable of scanning or imaging a document", thus, a device is being acquiring the image of a document.)

- "means for storing said at least one image and/or at least information extracted from image analysis" at fig.1 and col. 6, lines 18-33 and col. 7 , lines 10-37;

(Irons teaches, "Image storage mechanism 130 represents large scale secondary storage for storing images which are scanned/imaged by document input mechanism", thus the images being stored and information is retrieved.)

- "means for associating a label to said documents, said label comprising first information regarding the documents" at col. 7, lines 50-67 and col. 8 , lines 1-34; and

(Irons teaches, "the label has been generated and

applied to the first page of the incoming document" at col. 7 and lines 65-67.)

- "means for retrieving at least part of said information of said label" at col. 6 and lines 55-67;

(Irons teaches, "bar code label format or other high-density symbology and the eye-legible content provides information to the user regarding the document", thus the information is being retrieved from the use of the labels in the document.)

"Wherein said label is an electronic label" at col. 10, lines 57-65 and col. 11, lines 1-26.

(Irons teaches, "like an electronic stapler) a label directly onto the paper-based document", thus the electronic labels are included in the document.)

Note that claim 14 recites the same corresponding limitations as set forth in claims 14 above, thus the claim is rejected accordingly.

As per claim 2, Irons teaches, "apparatus for managing documents according to claim 1, wherein said electronic label is a transmitting and/or receiving unit" at col. 10, lines 10-65.

As per claim 4, Irons teaches, "apparatus for managing documents according to claim 1, further comprising a box for containing at least one document" at col. 10, lines 10-65.

As per claim 5, Irons teaches, "apparatus for managing documents according to claim 4 further comprising an electronic label associated to said box" at col. 6, lines 18-67 and col. 10, lines 10-65.

As per claim 6, Irons teaches, "apparatus for managing documents according to claim 4, wherein said electronic label associated to said box comprises second information regarding the box and the at least one document contained in said box" at col. 6, lines 18-67 and col. 10, lines 10-65.

As per claim 7, Irons teaches, "apparatus for managing documents according to claim 1, wherein said means for retrieving at least part of said information of said label comprises an electronic information reader and means for performing a logical operation concerning said information" at col. 16, lines 6-67.

As per claim 8, Irons teaches, "Apparatus for managing documents according to claim 4, wherein said box further comprises a memory for storing data" at col. 6, lines 18-67 and col. 10, lines 10-65.

As per claim 9, Irons teaches, "apparatus for managing documents according to claim 4, further comprising means for searching and/or retrieving document contents by querying information of the box memory" at "abstract" and col. 16, lines 18-67 and col. 10, lines 10-65 and col. 6, lines 18-33.

As per claim 10, Irons teaches, "apparatus for managing documents according to claim 1, wherein said first information is box identifier and/or box position" at "abstract" and col. 16, lines 18-67 and col. 10, lines 10-65 and col. 6, lines 18-33.

As per claim 11, Irons teaches, "apparatus for managing documents according

to claim 1, wherein said first information is box position" at "abstract" and col. 16, lines 18-67 and col. 10, lines 10-65 and col. 6, lines 18-33.

As per claim 12, Irons teaches, "apparatus for managing documents according to claim 1, wherein said information is the number of documents contained in said box" at "abstract" and col. 16, lines 18-67 and col. 10, lines 10-65 and col. 6, lines 18-33.

As per claim 13, Irons teaches, apparatus for managing documents according to claim 7, wherein said logical operation comprise comprises the steps of:
"retrieving first information from each document in order to have a first number associated to the count of the documents" at col. 7, lines 50-65 and col. 4, lines 13-15;
"retrieving second information from the box regarding the number of documents contained inside" at col. 7, lines 50-65 and col. 4, lines 13-15; and
"applying the difference between said first number and the number of documents retrived from the second information" at col. 7, lines 50-65 and col. 4, lines 13-15.

As per claim 15, Irons teaches, Method for managing documents according to claim 13, further comprising the steps of:
"processing document extracting digital text" at col. 4, lines 13-15 and col. 12, lines 18-54;
"retrieving at least part of said information of said text corresponding to specified text" at col. 4, lines 13-15 and col. 12, lines 18-54;
"retrieving the label of all the document connected to said text" at col. 4, lines 13-15 and col. 12, lines 18-54; and
"retrieving the box identifier and/or position of all the boxes connected to said text" at

col. 4, lines 13-15 and col. 12, lines 18-54.

As per claim 16, Irons teaches, Method for managing documents according to claim 13, further comprising the steps of:
“storing said at least one document in an enclosure” at “abstract” and col. 6, lines 18-67;
“associating a label to the enclosure, said label having its physical characteristics connected to the integrity of enclosure” at “abstract” and col. 6, lines 18-67; and
“retrieving, frequently in time at least part of said information of said label” at col. 17 and lines 7-31.

As per claim 17, Irons teaches, Method for managing documents according to claim 15, further comprising the steps of:
“moving the enclosure in a storage area” at col. 15 and lines 15-26;
“checking with a receiving transmitting means the presence of new labels” at col. 16 and lines 38-51; and
“updating a reference system for modification” at col. 16 and lines 38-51.

As per claim 18, Irons teaches, method for managing documents according to claim 15, further comprising the steps of:
“processing document extracting digital text” at col. 4, lines 13-15 and col. 12, lines 18-54; and
“storing said at least digital text in a memory located on the enclosure” at col. 6, lines 18-67 and col. 10, lines 10-65.

As per claim 19, Irons teaches, Method for managing documents comprising the steps of:

- "scanning an area with an emitter/receiver" at col. 8, lines 15-34;

(Irons teaches, "Imaging /scanning the image of the paper-based document is stored in an image repository", thus the documents being scanned and received in a storage.)

- "storing information of ray orientation and received signal" at col. 9, lines 5-25;
and

(Irons teaches, "to store and retrieve information from auxiliary storage devices, such as image storage mechanism " and "particular type or location of signal bearing media used to actually carry out the distribution", thus signal being received and stored.)

- "elaborating the stored information associating a label to said digital text wherein a physical position map is generated for documents and/or box" at col. 14, lines 32-57.

(Irons teaches, "Digital images of the paper-based documents can be written to a removable, transportable image storage media (CD-ROM, DVD, etc)", thus the digital text is being physically mapped and stored in a file.)

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Irons (U.S. Patent No. 6,192,165 B1) as applied to claim 1 above, and further in view of Berlin et al. (US Patent No. 6, 460,069 B1), here in referred to as Berlin.

Regarding claim 3, which is depends on claim 1, Irons discloses the claim invention as "apparatus for managing documents comprising: a device for acquiring at least one image of a document; means for storing said at least one image and/or at least information extracted from image analysis means for associating a label to said documents, said label comprising first information regarding the documents; and means for retrieving at least part of said information of said label; wherein said label is an electronic label" at col. 7, lines 10-37, at fig.1 and col. 6, lines 18-33, col. 7, lines 50-67, col. 10, lines 57-65 and col. 11, lines 1-26.

Irons does not appear to explicitly disclose for "apparatus for managing documents according to claim 1, wherein said electronic label is a RF tag".

However, Berlin teaches, "Apparatus for managing documents according to claim 1, wherein said electronic label is a RF tag" at col. 14, lines 34-50.

(Berlin teaches, "the use of a radio frequency (RF) Tag reader or scanner to obtain RF Tag information." it is clearly described that RF tag is being used in the electronic labeling.)

Irons and Berlin are analogous art because they are from the same field of endeavor for managing digital documentation.

At the time of the invention, it would have been obvious to one of ordinary skill in the art, having the teachings of Irons and Berlin before him or her, to modify the electronic label is a RF tag.

The suggestion/motivation for doing so would have been to be based on the identity of a data processing system provided by a central control system, the data collection system can transmit each document image to the identified data processing system", at col.3, lines 9-38.

Therefore, it would have been obvious to combine Irons with Berlin to obtain the invention as specified in the instant claim.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Ludtke (US Patent No. 7,188,110) discloses a secure and convenient method and apparatus for storing and transmitting telephony-based data.

Shanahan et al. (US Patent No. 6,820,075) discloses a Document-centric system with auto-completion.

Grefenstette (US Patent No. 6,928,425) discloses a System for propagating enrichment between document.

Ponzio Jr. (US Patent No. 7,197,542) discloses a system and method for signaling quality and integrity of data content.

Contact Information

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad N. Rahman whose telephone number is 571-270-1631. The examiner can normally be reached on 7:30am - 5:00 pm, Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mofiz Apu M can be reached on 572-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MR

AU 2161

/K. B. P./

/Apu M Mofiz/

Supervisory Patent Examiner, Art Unit 2161